

### **REMARKS**

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Office Action mailed June 8, 2007. Applicants respectfully submit that the amendment and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 22 are pending. In particular, Applicants amend claims 1, 10, 14, 19, and 20. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

#### **I. Rejections Under 35 U.S.C. §112**

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner asserts that claim 1 omits an element describing "how [a] message is transmitted from [a] sender to a recipient" (OA page element 3). Applicants respectfully traverse this rejection for at least the reason that essential structural elements are not necessary in a method claim, nor is there a requirement under 35 U.S.C. §112, second paragraph that a claim recite how a step is performed to be considered definite. Moreover, Applicants respectfully submit that nowhere in the present application is any such structure indicated as being "essential." For at least these reasons, Applicants submit that this rejection is improper and that claim 1 is allowable in view of 35 U.S.C. §112.

II. Rejections Under 35 U.S.C. §103

A. Lee in view of Arnold

1. Claim 1 is Allowable Over Lee in view of Arnold

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 2004/0093428 ("*Arnold*"). Applicants respectfully traverse this rejection for at least the reason that *Lee* in view of *Arnold* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A communication method comprising:  
receiving an instant messaging (IM) message from a sender to a first recipient;  
waiting a predefined time interval for an input from the first recipient, the input being responsive to the IM message; determining whether input from the first recipient is received during the predetermined time interval; and  
in response to determining that no input from the first recipient is received during the predetermined time interval, ***prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***  
(emphasis added)

Applicants respectfully submit that claim 1, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a "communication method comprising... in response to determining that no input from the first recipient is received during the predetermined time interval, ***prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***" as recited in claim 1, as amended. More specifically, *Lee* discloses a "meeting requester interact[ing] with [a] scheduler agent and creat[ing] the criteria 801 for [a] proposed meeting" (page 3, paragraph [0051]). Applicants respectfully submit that this is different than claim 1, as amended, for at least the reason that a meeting requester is different than prompting a user to send an instant message to a second sender and indicating that the

instant message is from the sender. For at least this reason, claim 1, as amended, is allowable over the cited art.

Additionally, *Arnold* fails to overcome the deficiencies of *Lee*. More specifically, *Arnold* discloses “[a]ddress data may conventionally be generated by a sender’s action of typing in or clicking on the displayed address, as well as automatic reply features inherent to Instant Messaging systems” (page 5, paragraph [0048]). Applicants respectfully submit that this is different than a “communication method comprising... in response to determining that no input from the first recipient is received during the predetermined time interval, ***prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 1, as amended, for at least the reason that address data being generated is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 1, as amended, is allowable.

## **2. Claim 5 is Allowable Over *Lee* in view of *Arnold***

The Office Action indicates that claim 5 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 (“*Lee*”) in view of U.S. Publication Number 2004/0093428 (“*Arnold*”). Applicants respectfully traverse this rejection for at least the reason that *Lee* in view of *Arnold* fails to disclose, teach, or suggest all of the elements of claim 5. More specifically, claim 5 recites:

A communication method comprising:  
receiving an instant messaging (IM) message from a first sender to a recipient;  
determining whether input from the recipient is received during a predetermined time interval;  
in response to determining that no input is received during the predetermined time interval determining whether the recipient is engaged in an IM chat session with a second sender; and  
in response to determining that the recipient is engaged in an IM chat session with the second sender, ***prompting the sender to send the***

***instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***  
(emphasis added)

Applicants respectfully submit that claim 5, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a “communication method comprising... in response to determining that the recipient is engaged in an IM chat session with the second sender, ***prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 5, as amended. More specifically, *Lee* discloses a “meeting requester interact[ing] with [a] scheduler agent and creat[ing] the criteria 801 for [a] proposed meeting” (page 3, paragraph [0051]). Applicants respectfully submit that this is different than claim 5, as amended, for at least the reason that a meeting requester is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 5, as amended, is allowable over the cited art.

Additionally, *Arnold* fails to overcome the deficiencies of *Lee*. More specifically, *Arnold* discloses “[a]ddress data may conventionally be generated by a sender’s action of typing in or clicking on the displayed address, as well as automatic reply features inherent to Instant Messaging systems” (page 5, paragraph [0048]). Applicants respectfully submit that this is different than a “communication method comprising... in response to determining that the recipient is engaged in an IM chat session with the second sender, ***prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 5, as amended, for at least the reason that address data being generated is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 5, as amended, is allowable.

3. **Claim 10 is Allowable Over Lee in view of Arnold**

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 2004/0093428 ("*Arnold*"). Applicants respectfully traverse this rejection for at least the reason that *Lee* in view of *Arnold* fails to disclose, teach, or suggest all of the elements of claim 10. More specifically, claim 10 recites:

A computer-readable medium comprising:  
computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a sender to a recipient;  
computer-readable code adapted to instruct a programmable device to wait a predefined time interval for an input from the recipient, the input being responsive to the IM message;  
computer-readable code adapted to instruct a programmable device to determine whether input from the recipient is received during the predetermined time interval; and  
computer-readable code adapted to instruct a programmable device to, in response to determining that no input from the recipient is received during the predetermined time interval, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***  
(emphasis added)

Applicants respectfully submit that claim 10, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a "computer-readable medium comprising... computer-readable code adapted to instruct a programmable device to, in response to determining that no input from the recipient is received during the predetermined time interval, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***" as recited in claim 10, as amended. More specifically, *Lee* discloses a "meeting requester interact[ing] with [a] scheduler agent and creat[ing] the criteria 801 for [a] proposed meeting" (page 3, paragraph [0051]). Applicants respectfully submit that this is different than claim 10, as amended, for at least the reason that a meeting requester is different than prompting a user to

send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 10, as amended, is allowable over the cited art.

Additionally, *Arnold* fails to overcome the deficiencies of *Lee*. More specifically, *Arnold* discloses “[a]ddress data may conventionally be generated by a sender’s action of typing in or clicking on the displayed address, as well as automatic reply features inherent to Instant Messaging systems” (page 5, paragraph [0048]). Applicants respectfully submit that this is different than a “computer-readable medium comprising... computer-readable code adapted to instruct a programmable device to, in response to determining that no input from the recipient is received during the predetermined time interval, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 10, as amended, for at least the reason that address data being generated is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 10, as amended, is allowable.

#### **4. Claim 14 is Allowable Over *Lee* in view of *Arnold***

The Office Action indicates that claim 14 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 (“*Lee*”) in view of U.S. Publication Number 2004/0093428 (“*Arnold*”). Applicants respectfully traverse this rejection for at least the reason that *Lee* in view of *Arnold* fails to disclose, teach, or suggest all of the elements of claim 14. More specifically, claim 14 recites:

A computer-readable medium comprising:  
computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first sender to a recipient;  
computer-readable code adapted to instruct a programmable device to determine whether input from the recipient is received during a predetermined time interval;  
computer-readable code adapted to instruct a programmable device to, in response to determining that no input is received during the

predetermined time interval, determine whether the recipient is engaged in an IM chat session with second sender; and  
computer-readable code adapted to instruct a programmable device to, in response to determining that the recipient is engaged in an IM chat session with the second sender, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***  
(emphasis added)

Applicants respectfully submit that claim 14, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a “computer-readable medium comprising... computer-readable code adapted to instruct a programmable device to, in response to determining that the recipient is engaged in an IM chat session with the second sender, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 14, as amended. More specifically, *Lee* discloses a “meeting requester interact[ing] with [a] scheduler agent and creat[ing] the criteria 801 for [a] proposed meeting” (page 3, paragraph [0051]). Applicants respectfully submit that this is different than claim 14, as amended, for at least the reason that a meeting requester is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 14, as amended, is allowable over the cited art.

Additionally, *Arnold* fails to overcome the deficiencies of *Lee*. More specifically, *Arnold* discloses “[a]ddress data may conventionally be generated by a sender’s action of typing in or clicking on the displayed address, as well as automatic reply features inherent to Instant Messaging systems” (page 5, paragraph [0048]). Applicants respectfully submit that this is different than a “computer-readable medium comprising... computer-readable code adapted to instruct a programmable device to, in response to determining that the recipient is engaged in an IM chat session with the second sender, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 14, as amended, for at least the reason that address data

being generated is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 14, as amended, is allowable.

5. **Claim 19 is Allowable Over Lee in view of Arnold**

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 (“Lee”) in view of U.S. Publication Number 2004/0093428 (“Arnold”). Applicants respectfully traverse this rejection for at least the reason that Lee in view of Arnold fails to disclose, teach, or suggest all of the elements of claim 19. More specifically, claim 19 recites:

A communication system comprising:  
means for receiving an instant messaging (IM) message from a sender to a recipient;  
means for determining whether the recipient has provided an input during a predefined time interval;  
means for, in response to determining that the recipient has not provided an input during the predetermined time interval, determining whether the recipient is engaged in an IM chat session with another sender;  
means for, in response to determining that the recipient is engaged in an IM chat session with another sender, replying to the IM message; and  
means for, in response to determining that the recipient is not engaged in an IM chat session with another user, ***prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***  
(emphasis added)

Applicants respectfully submit that claim 19, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a “communication system comprising... in response to determining that the recipient is not engaged in an IM chat session with another user, ***prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 19, as amended. More specifically, Lee discloses a “meeting requester interact[ing] with [a] scheduler agent and creat[ing] the criteria 801 for [a] proposed



meeting" (page 3, paragraph [0051]). Applicants respectfully submit that this is different than claim 19, as amended, for at least the reason that a meeting requester is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 19, as amended, is allowable over the cited art.

Additionally, *Arnold* fails to overcome the deficiencies of *Lee*. More specifically, *Arnold* discloses "[a]ddress data may conventionally be generated by a sender's action of typing in or clicking on the displayed address, as well as automatic reply features inherent to Instant Messaging systems" (page 5, paragraph [0048]). Applicants respectfully submit that this is different than a "communication system comprising... in response to determining that the recipient is not engaged in an IM chat session with another user, ***prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***" as recited in claim 19, as amended, for at least the reason that address data being generated is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 19, as amended, is allowable.

#### **6. Claim 20 is Allowable Over Lee in view of Arnold**

The Office Action indicates that claim 20 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 2004/0093428 ("*Arnold*"). Applicants respectfully traverse this rejection for at least the reason that *Lee* in view of *Arnold* fails to disclose, teach, or suggest all of the elements of claim 20. More specifically, claim 20 recites:

A communication system comprising:  
instant-messaging (IM) receive logic configured to receive an IM message from a sender to a recipient;  
first determining logic configured to determine whether the recipient has provided an input during a predefined time interval;

second determining logic configured to, in response to determining that the recipient has not provided an input during the predetermined time interval, determine whether the recipient is engaged in an IM chat session with another sender;

reply logic configured to, in response to determining that the recipient is engaged in an IM chat session with another sender, reply to the IM message; and

prompting logic configured to, in response to determining that the recipient is not engaged in an IM chat session with another sender, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***

***(emphasis added)***

Applicants respectfully submit that claim 20, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a “communication system comprising... prompting logic configured to, in response to determining that the recipient is not engaged in an IM chat session with another sender, in response to determining that the recipient is not engaged in an IM chat session with another sender, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 20, as amended. More specifically, Lee discloses a “meeting requester interact[ing] with [a] scheduler agent and creat[ing] the criteria 801 for [a] proposed meeting” (page 3, paragraph [0051]). Applicants respectfully submit that this is different than claim 20, as amended, for at least the reason that a meeting requester is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 20, as amended, is allowable over the cited art.

Additionally, Arnold fails to overcome the deficiencies of Lee. More specifically, Arnold discloses “[a]ddress data may conventionally be generated by a sender’s action of typing in or clicking on the displayed address, as well as automatic reply features inherent to Instant Messaging systems” (page 5, paragraph [0048]). Applicants respectfully submit that this is different than a “communication system comprising... prompting logic configured to, in response to determining that the recipient is not engaged in an IM chat session with another sender, in

response to determining that the recipient is not engaged in an IM chat session with another sender, ***prompt the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 20, as amended, for at least the reason that address data being generated is different than prompting a user to send an instant message to a second sender and indicating that the instant message is from the sender. For at least this reason, claim 20, as amended, is allowable.

7. **Claims 2 – 3, 9, 11 – 12, 18, and 22 are Allowable Over Lee in view of Arnold**

The Office Action indicates that claims 2 – 3, 9, 11 – 12, 18, and 22 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 (“Lee”) in view of U.S. Publication Number 2004/0093428 (“Arnold”). Applicants respectfully traverse this rejection for at least the reason that Lee in view of Arnold fails to disclose, teach, or suggest all of the elements of claims 2 – 3, 9, 11 – 12, 18, and 22. More specifically, dependent claims 2 – 3 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claim 9 is believed to be allowable for at least the reason that it depends from allowable independent claim 5. Dependent claims 11 – 12 are believed to be allowable for at least the reason that they depend from allowable independent claim 10. Dependent claim 18 is believed to be allowable for at least the reason that it depends from allowable independent claim 14. Further, dependent claim 22 is believed to be allowable for at least the reason that it depends from allowable independent claim 20. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**B. Claims 4, 8, 13, 17, and 21 are Allowable Over *Lee* and *Arnold* in view of *Glasser***

The Office Action indicates that claims 4, 8, 13, 17, and 21 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 ("*Lee*") and U.S. Publication Number 2004/0093428 ("*Arnold*") in view of U.S. Publication Number 2005/0108392 ("*Glasser*"). Applicants respectfully traverse this rejection for at least the reason that *Lee* and *Arnold* in view of *Glasser* fails to disclose, teach, or suggest all of the elements of claims 4, 8, 13, 17, and 21. More specifically, dependent claim 4 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 1. Dependent claim 8 is believed to be allowable for at least the reason that it depends from allowable independent claim 5. Dependent claim 13 is believed to be allowable for at least the reason that it depends from allowable independent claim 10. Dependent claim 17 is believed to be allowable for at least the reason that it depends from allowable independent claim 14. Further, dependent claim 21 is believed to be allowable for at least the reason that it depends from allowable independent claim 20. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**C. Claims 6 – 7 and 15 – 16 are Allowable Over *Lee* and *Arnold* in view of *Manabe***

The Office Action indicates that claims 6 – 7 and 15 – 16 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0233265 ("*Lee*") and U.S. Publication Number 2004/0093428 ("*Arnold*") in view of U.S. Patent Number 6,584,494 ("*Manabe*"). Applicants respectfully traverse this rejection for at least the reason that *Lee* and *Arnold* in view of *Manabe* fails to disclose, teach, or suggest all of the elements of claims 6 – 7 and 15 – 16. More specifically, dependent claims 6 – 7 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 5. Dependent claims 15

– 16 are believed to be allowable for at least the reason that they depend from allowable independent claim 14. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

### **III. Allegedly Well Known and Inherent Subject Matter**

In rejecting claims 1, 5, 10, 14, 19, and 20, the Office Action states “auto reply to an instant message is well known and inherent according to the description [of the cited art]” (OA e.g., page 3, last paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender, the subject matter in question is too complex for a reasonably skilled person to consider it to be well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well

known in the art, respectfully traverse the cited well known subject matter, and submit that claims 1, 5, 10, 14, 19, and 20 are patentable in view of the cited art.

### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

**Anthony F. Bonner Jr. Reg. No. 55,012**

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500  
Customer No.: **38823**